UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,156	10/17/2001	Adrianne Lewis	1248-R-01	5615

35811 7590 12/28/2004

IP DEPARTMENT OF PIPER RUDNICK LLP
ONE LIBERTY PLACE, SUITE 4900
1650 MARKET ST
PHILADELPHIA, PA 19103

EXAMINER	
MYHRE, JAMES W	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/981,156	LEWIS, ADRIANNE	
	Examiner	Art Unit	
	James W Myhre	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 September 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-8,10-18,20-25 and 27-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3-8, 10-18, 20-25, and 27-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 17, 2004 has been entered.

Response to Amendment

2. The amendment filed on September 17, 2004 has been considered but is ineffective to overcome the Von Kohorn (5,916,024) reference. The amendment canceled Claims 2, 9, 19, and 26; amended Claims 1, 8, 18, 25, 32, and 42; and added new Claims 43-46. Therefore, the currently pending claims considered below are Claims 1, 3-8, 10-18, 20-25, and 27-46.

Claim Objections

3. Claim 27 is objected to because of the following informalities: The amendment o September 17, 2004 canceled Claim 26. However, the dependency of Claim 27 was not amended, and thus it depends upon a canceled claim. The Examiner believes that

Claim 27 should now depend upon Claim 25 and will consider it thusly in the rejection below. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-8, 10-18, 20-25, and 27-42, and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Von Kohorn (5,916,024).

Claims 1, 8, 13, 18, 25, 32, and 42: Von Kohorn discloses a system, method, and computer program for advertising on a computer network, comprising:

a. Presenting an initial advertisement relating to a specific product or service (col 155, line 65 – col 156, line 1);

b. Prompting a player to access the advertisement by selecting an icon or link;

c. Incorporating one or more additional advertisements into an interactive game as active elements of the game (col 1, line 25 - col 10, line 43; col 47, lines 11-15; and col 141, line 58 – col 142, line 20);

d. Allowing the player to play the game based on the player's interaction with the initial advertisement (col 1, line 25 - col 10, line 43).

e. Tracking information relating to the highest scores for at least one time period (col 120, lines 43-52; col 121, lines 10-59; col 127, lines 39-41; col 144, lines 34-37; col 156, lines 45-49; col 157, lines 34-55; col 159, lines 29-35; and col 161, lines 52-55); and

f. Awarding at least one player with the highest score with a prize which may be used to obtain the advertised merchandise or service (col 120, lines 43-52; col 121, lines 10-59; col 127, lines 39-41; col 144, lines 34-37; col 156, lines 45-49; col 157, lines 34-55; col 159, lines 29-35; and col 161, lines 52-55).

The Examiner notes that Von Kohorn discloses that a plurality of products (i.e. advertisements) are presented to the user, who selects one of the products (col 79, lines 35-41) "by touching numbered buttons...or by other means" (col 85, lines 31-32) and is then directed to the game in order to "win" or qualify for some type of incentive for the selected product, such as a discount, coupon, free merchandise, etc. (col 102, lines 20-25). Thus, the product is selected prior to the user beginning to play the interactive game. Von Kohorn also explicitly discloses presenting the claimed "initial advertisement" by stating that "TV viewers/shoppers can be alerted to special promotions, deals, sales, free sample opportunities, and to contests, prizes and awards by televised announcement preceding the video game show (col 155, line 65 – col 156, line 1). Von Kohorn also discloses that the user is presented with information about the nature of the game (i.e. an advertisement to entice the user to play the game) prior to entering, such as the time when the game may start (col 92, lines 14-26), thus, again discloses an "initial advertisement". Von Kohorn also discloses that the game can

consist of one or more additional advertisements being displayed to the user during the game, who then responds to one or more queries about advertisement(s) in order to win the game, increase the player's score, or win a discount coupon for the product; thus the advertisements are active elements of the game (col 141, line 58 – col 142, line 20).

The Examiner notes that the disclosure that the user may make a selection through the response device by touching numbered button or by other means would encompass other known input means, such as a mouse, track ball, joystick, touch screen, etc. as discussed by Von Kohorn (col 133, lines 31-38) The presentation of additional information about the product or service to the user when a selection is made implies that the selection is "linked" to the additional information files.

Claims 3, 10, 20, 27, and 34: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, 25 and 32 above, and further discloses that the game is a trivia game and that the additional advertisement provides clues to the trivia questions (col 1, line 25 - col 10, line 43; col 43, lines 1-15; and col 119, lines 4-8).

Claims 4, 11, 21, and 28: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, and 27 above, and further discloses prompting the player to access advertisements on the advertiser's website in order to progress in the game (col 1, line 25 - col 10, line 43).

Claims 5, 12, 22, 29, and 35: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, 28, and

32 above, and further discloses providing one or more prizes to winning players (col 1, line 25 - col 10, line 43).

Claims 6, 14, 15, 23, 30, and 36: Von Kohorn discloses a system, method, and computer program for advertising on a computer network including the steps in Claims 1, 8, 13, 18, 29, and 32 above, and further discloses compiling demographic information on the player and targeting the advertisement based on the player's demographic information (col 1, line 25 - col 10, line 43 and col 137, lines 40-67).

Claims 7, 16, 24, 31, and 33: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, 30, and 32 above, and further discloses that the game is one of a trivia game, bingo, dominoes, casino games, card games, tic-tac-toe, or jigsaw puzzle (col 1, line 25 - col 10, line 43 and col 119, lines 4-8).

Claim 17: Von Kohorn discloses a method for advertising on a computer network as in Claim 8 above, and further discloses placing the game into a computer advertising spot (col 1, line 25 - col 10, line 43).

Claims 37-40: Von Kohorn discloses a system, method, and computer program for advertising on a computer network as in Claims 1, 8, 18, and 25 above, and further discloses that the initial advertisement is accessible independent of accessing an advertiser's website. Von Kohorn explicitly discloses that the advertisements may be downloaded to the user's remote device prior to the user accessing the advertisement or game program. This downloading may be from online or through the use of a memory disk distributed to the user (col 29, lines 27-34; col 79, line 62 - col 80, line 7;

and col 140, lines 59-67). Thus, when the user begins, an initial advertisement is presented to the user without necessitating the user connecting to the advertiser's website.

Claim 41: Von Kohorn discloses a method for advertising on a computer network as in Claim 4 above, and further discloses that the advertising material is one of images of products, marketing messages, logos, taglines, and jingles (col 18, lines 23-29 and col 47, lines 9-19).

Claim 44: Von Kohorn discloses a method for advertising on a computer network, comprising:

a. Incorporating one or more additional advertisements into an interactive game as active elements of the game (col 1, line 25 - col 10, line 43; col 47, lines 11-15; and col 141, line 58 – col 142, line 20);

b. Presenting the game to one or more players (col 1, line 25 - col 10, line 43; col 47, lines 11-15; and col 141, line 58 – col 142, line 20);

c. Requiring the players to actively use the advertisements to play the game (col 1, line 25 - col 10, line 43; col 47, lines 11-15; and col 141, line 58 – col 142, line 20);

d. Prompting a player to access the advertisement by selecting an icon or link independent of accessing an advertiser's website. Von Kohorn explicitly discloses that the advertisements may be downloaded to the user's remote device prior to the user accessing the advertisement or game program. This downloading may be from online or through the use of a memory disk distributed to the user (col 29, lines 27-34; col 79,

line 62 - col 80, line 7; and col 140, lines 59-67). Thus, when the user begins, an initial advertisement is presented to the user without necessitating the user connecting to the advertiser's website.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 43, 45, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Kohorn (5,916,024) in view of Spaur et al (6,196,920).

Claims 43, 45, and 46: Von Kohorn discloses a method for presenting advertising on a computer network as in Claims 1 and 44 above, and further discloses the player selecting one or more of the advertised products "by touching numbered buttons on a respondent's entry device, or by other means" (col 85, lines 31-32), but does not explicitly disclose clicking on the active game element (advertising), not that the advertising image is used "as a game piece". However, Spaur discloses a similar method for advertising on a computer network in which the advertising is displayed on the back of cards used to play an online card game (col 4, lines 26-29; col 9, lines 50-59; and col 15, lines 17-21), and further discloses the user "clicking" on the card backs to play the game and/or to access additional information about the advertised product (col 3, lines 43-45 and col 14, lines 13-17). Therefore, it would have been obvious to

one having ordinary skill in the art at the time the invention was made to utilize an input device, such as a mouse, to select the desired advertised products in Von Kohorn by "clicking" the mouse button. It would also have been obvious that Von Kohorn's game could consist of a card game format with the advertisements being the "game pieces" (cards). One would have been motivated to use a mouse click to select an advertising game piece in Von Kohorn in order to facilitate the quick entry of the selections by players, including those who are slow "typists", especially in view of Von Kohorn's disclosure of timed games in which players compete against other players.

Response to Arguments

8. Applicant's arguments filed September 17, 2004 have been fully considered but they are not persuasive.

a. The Applicant argues that the various elements disclosed by Von Kohorn are not combinable and cites the Declaration of Mr. Kanter, dated September 11, 2004, as proof that one of ordinary skill in the art would not have combined the elements to arrive at the claimed invention. The Examiner has read and considered the Declaration and notes that Mr. Kanter has reiterated the same arguments presented by the Applicant during the prosecution of this application in that it is his belief that the reference does not teach "the use of advertising images as active game elements", "collecting demographic information and using that information to tailor advertising content to individual players", and that there is no suggestion to combine "the elements into a

single implementation". These arguments are not persuasive and are discussed both in the rejection above and in the following responses to the Applicant's arguments.

b. The Applicant argues that Von Kohorn does not disclose that the advertising image is an active element of the game because the user does not "click on the image, or otherwise actively use it in any way." (pages 14-15). However, the Examiner notes that the user must first select which advertising images are desired, read or otherwise ascertain the information provided in the advertising, and then answer one or more questions about the advertising. The Examiner considers this as actively using the advertising image. If the advertising image was not used (i.e. not viewed, read, or referred to) the user could not play the game. As for the argument that actively using the image pertains only to clicking on the image or using it as a game piece, the rejection of the new claims incorporating these features combines Von Kohorn with Spaur, who explicitly uses the advertising images as the backs of cards while the user is playing online card games and who also discloses the user making selection by clicking on a button on a mouse.

c. The Applicant argues that Von Kohorn does not suggest tailoring advertising content based on the player's personal information (pages 16-17). However, the Examiner notes that Von Kohorn explicitly discloses recording various demographic data about a player (col 136, lines 58-62 and col 137, lines 34-56) and further discloses the player selecting a category or area of interest and then receives advertising and associated questions pertaining only to the selected category or area of interest (col 6, lines 27-52). This selection, which is used to determine what advertising to display to

the player, is one form of "personal information" about the player in that it indicates the player's "area of interest". Thus, Von Kohorn discloses selecting (tailoring) the advertising content in the game to the player's personal information (desired category or area of interest).

d. The Applicant also argues that as discussed in Mr. Kanter's Declaration, the present "invention has solved a long felt need in the art to make Internet advertising acceptable to Internet users" and did so in a manner that "was non-obvious to those in the field" (pages 17-19). The Examiner notes that in order to "make Internet advertising acceptable to Internet users" the present application incorporates advertisements as an integral part of an online game. This is the same approach used, not only by Von Kohorn, but by several other inventors, both of record and not of record. For example, Spaur (filed 1998), used in the 35 U.S.C. 103 rejection above, incorporates advertisements on the back of cards during an online card game (among other variations). Vaughn et al (5,643,088)(filed 1995), previously provided, integrates advertisements with an online game of skill or chance. Heckel (6,036,601)(filed 1999), previously provided, also incorporates advertising into virtual games online. Thus, the "long felt need in the art" has been addressed by numerous inventors almost since the Internet became publicly popular. Thus, by the time of the present invention, it would have been obvious to incorporate advertisements into online games in order to "make Internet advertising acceptable to Internet users" even without Von Kohorn's explicit disclosure.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

JWM
December 21, 2004

James W. Myhre
Primary Examiner
Art Unit 3622